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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,767	05/14/2001	Isao Horiuchi	HORIUCHI-6	9992
1444	7590	06/23/2004	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			YU, GINA C	
		ART UNIT	PAPER NUMBER	
		1617		

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/831,767	HORIUCHI, ISAO
	Examiner Gina C. Yu	Art Unit 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 04 November 2003.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 9-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 9-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 4, 2003 has been entered.

The advisory action mailed January 2, 2004 is hereby withdrawn because due to an internal delay applicants' request for continued examination was not timely presented to the examiner at the time of the issuing the action.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoi et al. (JP408198724A) ("Yokoi") in view of Ogawa (JP411228439A).

Yokoi teaches skin cosmetic composition 0.001-20 % of supernatant liquid of culture of lactic acid bacteria. See Constitution. The reference teaches that the composition, which also contains hyaluronic acid or its salt, has "excellent massaging effect" and "high moisture retention" properties, among others. The reference further teaches that the composition "is usable with ease without damaging skin by action of hyaluronic acid".

While the reference does not mention "a agent for stabilizing living cells with adjustment of cytolysis action of the cells by said protease", it is well settled in patent law that a compound and its properties are inseparable. See In re Papesch, 315 F.2d, 381, 137 U.S.P.Q. 43 (C.C.P.A., 1963). Thus, the recited "agent" must be also present in the Yokio culture supernatant.

The Yokoi reference does not teach a protease.

Ogawa teaches a topical composition comprising an extract from the mycelia of *Agaricus blazei* Murill in combination with other skin care actives. See Abstract. The reference that the mycelia extract is used in the amount of 0.0001-5 wt %. See Solution. See instant claim 12. The reference teaches that the composition is effective for prevention/improvement of skin aging symptoms. The composition also contains hyaluronic acid.

Claim 9 recites a process limitation which describes how the claimed cell culture is prepared. Examiner respectfully points out that the court in In re Thorpe held, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the production in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See 777 F.2d 695, 698, 227 U.S.P.Q. 964, 966 (Fed. Cir. 1985). In this case, the claims are directed to a composition. The proposed limitation of the process of which how the culture supernatant is obtained is not given patentable weight because the composition

itself is viewed an obvious variation of the prior arts, and the patentability of the composition does not depend on the process of making the product. How the culture supernatant is prepared does not change the fact that the culture supernatant is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the composition of Yokoi and Ogawa because it is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose. See In re Kerkhoven, 205 U.S.P.Q. 1069 (C.C.P.A. 1980). Both the Yokio bacteria cell supernatant and the Ogawa protease are used for skin care purposes, and thus it is *prima facie* obvious to combine these ingredients to make a third skin care cosmetic composition.

Alternatively, the skilled artisan would have been motivated to modify the Yokio composition by adding the extract of mycelia of *Agaricus blazei* Murill as motivated by Ogawa because 1) both references are directed to skin care compositions utilizing hyaluronic acid, 2) Ogawa specifically teaches that the protease improves skin aging symptoms. The skilled artisan thus would have had a reasonable expectation of successfully producing a skin care composition which has good massaging effect, high moisture retention effects, and anti-aging effects.

#### ***Response to Arguments***

Applicant's arguments filed November 4, 2003 have been fully considered but they are moot in view of new grounds of rejections.

***Conclusion***

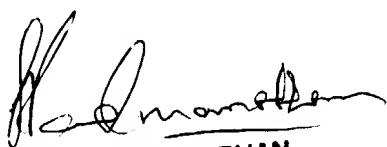
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER